Applicant : Ostertag et al.
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Attorney's Docket No.: 13905-042001 / 2003P00093
US

REMARKS

In response to the Office Action dated July 25, 2006, Applicants are amending claims 1, 12, 13, 14, 25, 26, 27, 38, 39, 40, 50, 51, 52, 62, 63, 64, 74 and 75. As such, claims 1-20, 22-33, 35-46, 48-58, 60-70 and 72-75 remain pending. Claims 76-111 have been withdrawn. Favorable reconsideration in view of the amendments and the following remarks is requested.

The independent claims have been amended to omit mentioning of an explicit data source and to require that the searching be done in "at least one implicit data source." Corresponding amendments have been made in the respective dependent claims that mention explicit or implicit data sources. Support for these amendments is found in the claims as filed and also in the specification, for example in paragraphs 0042 and 0053-54. Moreover, the claim language regarding the search being without regard to an individual's membership in a defined group, an amendment that was made in response to a previous office action, has been omitted. Support for this amendment is found in the wording of the claims as filed. No new matter is added.

Initially, Applications will briefly address the interpretation of one claim term. In a previous Office Action dated June 30, 2005, the Examiner objected to some claims because of the claim term "enterprise resource planning system". In the response filed November 21, 2005, Applicants traversed this objection, and it was later withdrawn by the Examiner. The Examiner's interpretation of the claim term as stated in the current Office Action ("could be broadly interpreted as 'any planning system'") appears to not give any weight to the words "enterprise resource" that Applicants have used to modify the terms "planning system" in the claims. As such, it appears that the Examiner's interpretation may not be correct. Applicants are therefore not conceding the correctness of this interpretation and reserve the right to challenge it at any later time during or after prosecution.

Claims 1-20, 22-33, 35-46, 48-58, 60-70 and 72-75—that is, all pending claims—were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. 6,480,885 ("Olivier"). This rejection is traversed. Applicants submit that the pending claims are allowable over the prior art of record.

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Applicants claim 1 is directed to a method of mining human capital information. The method includes identifying individuals of a dynamic target group by searching at least one implicit data source. The human capital information is mined, as recited in the method claim, by analyzing logged communications with the individuals of the dynamic target group. Independent claim 40 is drawn to a method of establishing a target group. But all independent claims recite the feature regarding searching an implicit data source. Olivier does not anticipate or render obvious a method in which individuals of a dynamic target group are identified by searching an implicit data source.

Applicants have characterized Olivier in several previous responses and those comments are incorporated here. For brevity, Applicants will note that the disclosure in Olivier relates to "electronic communication within group forums". Olivier: column 1, lines 24-28 (hereafter referred to as Olivier 1:24-28). According to Olivier, when a user sending a message to a mailing list "an email server retrieves her 100% matches and then optionally filters her recipient list down to a message distribution list using each recipient's message criteria". Olivier 3:17-21. But Olivier does not disclose or suggest searching an implicit data source.

Regarding the prior version of claim 1, the Examiner stated in part:

> [S]earching for "neighborhood" members to a participant requires the use
> of the participant's dynamically defined criteria such as distance and the
> search scope must cover the entire membership database because each
> member has his/her own definition of interested neighbors such as
> distance from the subscriber's home address.

It is not clear whether this was specifically intended to address the use of explicit or implicit data sources (both terms were then recited in the claim), but Applicants note the following. A preexisting email distribution list as taught in Olivier is not an implicit data source. This is because the distribution list is generated using explicit submissions made by those who wish to join the list. As such, it is an explicit data source. The present specification points out that advantages can be gained by "defining a target group based on one or more attributes <u>rather</u>

than explicitly defining the members" and by defining distribution lists "by their membership

criteria, rather than by membership. Specification paragraphs 0012, 0076 (emphases added).

Particularly, the current independent claims state that the individuals of a dynamic target group

are identified by searching an implicit data source.

   Olivier, in contrast, does not teach or suggest the searching of an implicit data source.

The Examiner's reliance on Olivier 16:56-66 (see page 6 of Office Action) appears to be

mistaken. There, Olivier teaches that the subscription settings are a default that the user can

override when sending a message. Applicants point out that this change is initiated by the user at

the sender side of the message, and Olivier still determines the distribution list based on the

subscriber list just as if the user did not override the default subscription setting. Olivier: 16:63-

65 (stating that the subscription matching process described in Figure 5B of Olivier is used to

determine the distribution list). Contrary to the Examiner's assertion, the "additional processing"

that Olivier requires due to the overriding attributes does not somehow transform Olivier's

filtering of the subscriber list into a search of an implicit data source. The other independent

claims have corresponding language regarding the searching of an implicit data source.

   Thus, Olivier does not teach or suggest the feature of the present claims that individuals

of a dynamic target group are identified by searching an implicit data source. As such, it cannot

be said that Olivier anticipates or renders obvious the independent claims or any of the

dependent claims. The pending claims are therefore patentable over Olivier. Applicants request

that the Examiner remove the rejection of all pending claims 1-20, 22-33, 35-46, 48-58, 60-70

and 72-75.

   It is believed that all of the pending claims have been addressed. However, the absence

of a reply to a specific rejection, issue or comment does not signify agreement with or

concession of that rejection, issue or comment. In addition, because the arguments made above

may not be exhaustive, there may be reasons for patentability of any or all pending claims (or

other claims) that have not been expressed. Finally, nothing in this paper should be construed as

an intent to concede any issue with regard to any claim, except as specifically stated in this

paper, and the amendment of any claim does not necessarily signify concession of

unpatentability of the claim prior to its amendment.
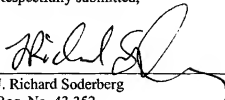
This response is filed within the shortened statutory period and no fee is therefore due.
Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: __10/20/06__

J. Richard Soderberg
Reg. No. 43,352

Fish & Richardson P.C.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696

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